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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/529,629 | 03/31/2005 | Frank Dietsche | 12810-00042-US1 | 1355 |
| 30678 7590 06/11/2009 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006 | | | | |
| EXAMINER | | | | |
| CHORBAJ, MONZER R | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/529,629

Applicant(s)

DIETSCH ET AL.

Examiner

MONZER R. CHORBAJI

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11. does NOT place the application in condition for allowance because:

On pages 2-4 of the Remarks section; Applicant argues that Tropsch fails to suggest that the sum of styrenesulfonic acid, N-vinylpyrrolidone, and acrylonitrile totals 100% where instead, the prepolymers of Tropsch comprise (col.9, line 25) from 1 to 100% of a primary vinylamine; that as taught in Tropsch (col.1, lines 4-20), the polymers necessarily comprise primary vinylamine monomers where some or all of which are of formula I and/or II; that a primary vinylamine cannot reasonably be considered to correspond to styrenesulfonic acid; that the assertion in col.9, lines 26 and 39-40 of Tropsch by the examiner that Tropsch teaches a composition comprising 99 mol% N-vinylpyrrolidone and 1 mol% styrenesulfonic acid is incorrect; and that the office action does not specify how *In re Wertheim* is applied.

Tropsch teaches (col.2, lines 26-27) that the sum of all mole percentages is equal to 100 (col.2, lines 26-27) where one recognizes that formula IV or V is included in this teaching. Tropsch further teaches that the concentrations of the various components greatly vary. For example, Tropsch teaches in one embodiment (col.9, lines 34-67 and col.10, lines 1-53) that the composition comprises compounds a and b and also includes additional prepolymers or also known as prepolymers such as styrenesulfonic acid (considered as a in the recited claim) where the total mole percent is still 100. The composition in col.9, line 25 can be made up of only primary vinylamine (considered also as component a in the claim) at 100 mol%, or the composition in col.9, lines 26 and 39-40 can be made up of 99 mol% of N-vinylpyrrolidone (considered as component b in the claim) and 1 mol% of styrenesulfonic acid (considered as a in the claim), or the composition in col.9, lines 25-26 and lines 39-40 can be made up of 1 mol% of primary vinylamine and 99 mol% of styrenesulfonic acid, or the composition in col.9, lines 25-31 and lines 39-40 can be made up of the following: 1 mole% of primary vinylamine (considered as component b in the claim); and 90 mol% of acrylonitrile (considered as component c in the claim) and 9 mole% of formula IV or V.

In re Wertheim is applied to show that claimed ranges that lie inside ranges disclosed by the prior art, Tropsch et al., is a *prima facie* obvious in view of prior art reference teachings.